Supreme Court, U.S.
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No. 00-1543

IN THE
Supreme Court of the United States

FESTO CORPORATION,

Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO, LTD.,
A/K/A SMC CORPORATION AND SMC PNEUMATICS, INC.,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

The *en banc* Federal Circuit, based on its extensive experience grappling with the issues in large numbers of cases, resolved several questions about the standards for prosecution history estoppel, a longstanding and essential limit on the availability of the doctrine of equivalents. Two questions are presented in the petition:

1. Whether prosecution history estoppel applies when a claim element is narrowed to satisfy the statutory requirements for patentability, as the *en banc* Federal Circuit held, or instead applies only to some subset of the statutory patentability requirements.

2. When estoppel applies to such a narrowed claim element, whether estoppel bars equivalents for that element, as the *en banc* Federal Circuit held, or instead allows an undefined range of equivalents for that element.

CORPORATE DISCLOSURE STATEMENT

SMC Corporation is the parent of SMC Pneumatics, Inc.

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BRIEF IN OPPOSITION

The Federal Circuit decided this case *en banc* in the performance of its essential role of refining the rules governing assertions of infringement under the doctrine of equivalents to ensure that the public notice function of the patent claiming system is not defeated by that doctrine. As this Court stressed in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997), prosecution history estoppel is a longstanding and essential limit on patentees' ability to reach otherwise-available equivalents by extending their patent monopolies beyond the claim terms they specifically adopted in the PTO to secure issuance of their patents. In the years following *Warner-Jenkinson*, the Federal Circuit decided a plethora of cases

reflecting the persistent and well-recognized uncertainty about the proper estoppel standards and how those standards would apply to particular patents. Based on its unique and extensive experience, the Federal Circuit in this case resolved the doctrinal confusion and did so in a way that furthers the important public-notice and PTO-primacy policies of the patent law, enhancing the public's ability to determine a patent's boundaries and thus reducing the chill that unpredictability places on competition and further innovation. The Federal Circuit's decision should stand.

STATEMENT

A. This Case

This case involves two patents owned by petitioner Festo: the Stoll patent and the Carroll patent, both of which involve a magnetic rodless cylinder with three basic parts – a piston, a cylinder, and a sleeve.[1] The piston is inside the cylinder and is moved by fluid under pressure. The sleeve is outside the cylinder and is magnetically coupled to the piston, so that a magnetic attraction between the sleeve and the piston causes the sleeve to follow the piston as the piston moves inside the cylinder. The sleeve is used to move objects on a conveying system. Pet. App. 33a.

[1]Although Festo's legal arguments do not depend on its touting of its patents' contribution to rodless cylinder technology, the record makes clear that Festo's patents were at most narrow improvement patents, secured by addition of specific narrowing limitations – which were not present in the accused rodless cylinders. Magnetic rodless cylinders were described in the prior art beginning in the early 1960s. Fed. Cir. Jt. App. A8631-35.

During prosecution of the Stoll patent application, Festo amended the main claim to recite a sealing ring at each end of the piston. Pet. App. 40a. These sealing rings "prevent any impurities from getting on the piston." Pet. App. 33a. Festo also amended its main claim to recite magnetizable material in the sleeve. Pet. App. 40a. This magnetizable material "allows 'magnetic leakage fields in the vicinity of the driven assembly to be kept to a minimum,' preventing any unwanted braking forces." Pet. App. 34a (quoting Stoll patent). As the Federal Circuit concluded, Festo added the limitation requiring two sealing rings in order *to avoid prior art*. Pet. App. 52a. The addition of the limitation requiring magnetizable material, Festo asserted, was an unexplained "mystery" – a conclusion with which the district court and Federal Circuit agreed.[2]

The Carroll patent issued in 1973. Fifteen years later, in 1988, after Festo discovered prior art not previously disclosed to the PTO, Festo requested reexamination of its patent. During the reexamination process, Festo amended the main claim of its patent to recite a sealing ring at each end of the piston. Pet. App. 35a-39a, 42a. Festo asserted that its main claim was a combination claim that owed its patentability to the combination of the recited elements. Pet. App. 42a-43a. As with the Stoll application, the Federal Circuit held that the

[2]"The [district] court concluded that the reason for the magnetizable sleeve element was '*a mystery*,' because it did not appear to be related to any of the examiner's 35 U.S.C. §112 rejections, and it did not appear to distinguish the invention over the prior art." Pet. App. 44a (emphasis added). The Federal Circuit unanimously concluded that, under the presumption of estoppel set forth in *Warner Jenkinson*, an unexplained amendment bars equivalents for the added element. Pet. App. 31a. That conclusion, by itself, bars infringement of the Stoll patent, even without consideration of the separate limitation requiring two sealing rings.

limitation requiring two sealing rings was added *to avoid prior art*.[3]

Although Festo insinuates otherwise, the rodless cylinder produced by respondents (collectively "SMC") was not copied from Festo's rodless cylinder.[4] SMC's cylinder did not include two sealing rings. SMC's cylinder also did not include magnetizable material in the sleeve. Those differences ruled out literal infringement. Pet. App. 48a, 53a.

Festo was therefore forced to resort to the doctrine of equivalents. Pet App. 44a. Although Festo had made clear to the PTO, through its amendments to include the specific elements in its patent claims, that it was important to its invention to have (1) a sealing ring at each end of the piston and (2) magnetizable material in the sleeve, Festo had to reverse course to allege infringement by equivalents. Festo now asserted that (1) a sealing ring at each end of the piston and (2) magnetizable material in the sleeve were so unimportant that their *absence* was "equivalent" to their *presence*. Festo prevailed in the district court. Pet. App. 32a.

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[3]"The prosecution history of the Carroll patent reveals that the amendment that added the pair of sealing rings claim element was motivated by at least one reason related to patentability: *a desire to avoid the prior art*." Pet. App. 55a, emphasis added.

[4]Throughout its petition, Festo pejoratively implies that SMC is an "unscrupulous copyist." This is a serious misrepresentation. As unequivocally held by the district court, "[y]ou're right, there is no evidence of copying." Fed. Cir. Jt. App. A1604.

B. Panel Decisions

Prior to its *en banc* decision, the Federal Circuit decided this case twice. In 1995, it affirmed the district court judgment. Pet. App. 190a-207a. After this Court vacated that decision and remanded for reconsideration in light of *Warner-Jenkinson* (*Shoketsu Kinzoku Kogyo Kabushiki Co. v. Festo Corp.*, 520 U.S. 1111 (1997)), the Federal Circuit panel in 1999 modified its earlier ruling, now affirming in part but remanding for further examination of estoppel issues with respect to the Stoll patent requirement of two sealing rings. Pet. App. 156a-189a.

C. The Federal Circuit's *En Banc* Decision

By the summer of 1999, the Federal Circuit had addressed the applicability and scope of estoppel in a large number of prosecution history estoppel cases since *Warner-Jenkinson*, including in the two cases (along with this one) that this Court remanded for reconsideration in light of *Warner-Jenkinson*.[5] *See* 5A D. Chisum, *Patents* §18.05 (1998 & 2000 Supp.); 13 D. Chisum, *Patents*, Federal Circuit Topical Outline, sections 5410-5418 (summarizing numerous estoppel decisions) (1998 & 2000 Supp.). On August 20, 1999, the Federal Circuit vacated the panel decision and set this case for rehearing *en banc*, stating five doctrinal questions for the parties and *amici* to address, four concerning prosecution history estoppel. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,187 F.3d 1381 (Fed. Cir. 1999); *see* Pet. App. 2a-3a (quoting the five

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[5]*Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449 (Fed. Cir.), *reh'g denied over dissents*, 145 F.3d 1472 (Fed. Cir. 1998); *Hughes Aircraft Co. v. United States*, 140 F.3d 1470 (Fed. Cir.), *reh'g denied over dissents*, 148 F.3d 1384 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1177 (1999).

questions).[6] On November 29, 2000, the court rendered its *en banc* decision, deciding the estoppel questions and resolving this case. Pet. App. 1a-155a.

The court's rulings, as relevant here, are by their express terms limited to the situation of (a) an amendment made by the patent applicant in the PTO (b) that narrows the claim. That class of amendments can make a difference in infringement litigation only where the narrowing amendment adopted a claim limitation that the accused product or process does not meet literally – so that the patentee alleging infringement must rely on equivalents for that element to meet the requirement (the "all-elements rule") that each claim element be met literally or by an equivalent. *See Warner-Jenkinson*, 520 U.S. at 29. For this class of equivalents cases, the Federal Circuit adopted two rules at issue here.

The court first concluded, by a vote of 11 to 1, that a narrowing amendment generates estoppel if made for any reason related to the statutory requirements for a patent. For such narrowing amendments, the court held, estoppel is not restricted to those made specifically to avoid prior art. The

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[6]The first question presented in Festo's certiorari petition is substantively the same as the Federal Circuit's question one: "For the purposes of determining whether an amendment to a claim creates prosecution history estoppel, is 'a substantial reason related to patentability,' *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997), limited to those amendments made to overcome prior art under §102 and §103, or does 'patentability' mean any reason affecting the issuance of a patent?" *See* Pet. App. 2a. Festo's second question presented is substantively the same as the Federal Circuit's question three: "If a claim amendment creates prosecution history estoppel, under *Warner-Jenkinson* what range of equivalents, if any, is available under the doctrine of equivalents for the claim element so amended?" Pet. App. 2a-3a.

court explained that "the functions of prosecution history estoppel [the notice function of the claims and the prevention of recapture of surrendered subject matter] cannot be fully satisfied if substantial reasons related to patentability are limited to a narrow subset of patentability issues." Pet. App. 8a-11a.

The court next addressed the scope of the applicable estoppel, *i.e.*, what if any equivalents are precluded, or remain available, when estoppel applies by virtue of a narrowing amendment that is determined to have been made for patentability reasons. By a vote of 8 to 4, the court held that, when such a narrowing amendment generates estoppel, the claim limitation added by the amendment is not subject to equivalents infringement: the patentee's eyes-open choice of the narrowing language defines the boundaries for that claim element.[7] The patentee remains free to establish equivalents for all other elements of the claim. Pet. App. 13a-30a.[8]

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[7]By a unanimous vote (12-0), the court separately held that *Warner-Jenkinson* bars equivalents infringement for an "unexplained" amendment (such as the "magnetizable material"). Pet. App. 4a.

[8]Although the petition repeatedly suggests that the estoppel ruling in this case eliminates the doctrine of equivalents, that suggestion ignores the express terms of the ruling here. The ruling has no application to any claims that were not amended in the PTO. The ruling likewise has no application to claims amended in a way that does not narrow them. Even for claims that were narrowed by amendment, the ruling applies only to the particular claim limitation introduced by the narrowing amendment: the other elements of even that claim (let alone other claims) remain unaffected, subject to the otherwise-applicable doctrine of equivalents. The estoppel ruling here applies, in short, only to the particular claim elements that were isolated for attention in the PTO and subject to applicant-drafted and applicant-accepted narrowing as a result.

In reaching this conclusion, the court initially reasoned that this Court's decisions, though providing distinct support for this "complete bar" rule, did not settle the issue. Pet. App. 13a-19a. The court further explained that its own precedents over the past 20 years had been inconsistent on this issue, some cases following a "flexible" approach (allowing some undefined range of equivalents for elements added by narrowing amendments), some cases following a strict "no equivalents" approach holding the patentee to the language of the element added by amendment. Pet. App. 19a-24a.[9] The court then resolved the question on the merits by relying on its "nearly twenty years of experience in performing [its] role as the sole court of appeals for patent matters." Pet. App. 24a. It explained, based on its "long experience" (Pet. App. 25a), that the flexible approach was "unworkable" (Pet. App. 25a) because it defeated the definitional and notice function of patent claims, making the boundaries of forbidden territory "virtually unascertainable" and deterring investment in innovation in the proximity of patented subject matter. Pet. App. 28a.

More particularly, the Federal Circuit anchored its refinement of the standards for estoppel in "its special

[9]The "flexible" approach grew out of *Hughes Aircraft Co. v. United States*, 717 F.2d 1351 (Fed. Cir. 1983) [*Hughes I*], which stated that estoppel, once found applicable, "may have a limiting effect" on available equivalents "within a spectrum ranging from great to small to zero." *Id.* at 1363. (The *Hughes Aircraft* litigation continued for a quarter century. *See* note 5, *supra*.) The stricter approach was articulated almost contemporaneously in *Kinzenbaw v. Deere & Co.*, 741 F.2d 383 (Fed. Cir. 1984), *see* Pet. App. 20a, as well as by pre-Federal Circuit regional appellate court precedent, *see, e.g.*, *Nationwide Chemical Corp. v. Wright*, 584 F.2d 714, 718-20 (5th Cir. 1978); *Ekco Prods. Co. v. Chicago Metallic Mfg. Co.*, 347 F.2d 453, 454-55 (7th Cir. 1965).

expertise" based on its unique experience, as contemplated by *Warner-Jenkinson*, 520 U.S. at 40. The court explained:

> Congress contemplated that the Federal Circuit would "strengthen the United States patent system in such a way as to foster technological growth and industrial innovation." *Markman [v. Westview Instruments, Inc.]*, 517 U.S. [370, 390 (1996)]. Issues such as the one before us in this case are properly reserved for this court to answer with "its special expertise." *Warner-Jenkinson*, 520 U.S. at 40 (reserving explicitly for the Federal Circuit the task of formulating the proper test(s) for infringement under the doctrine of equivalents).

Pet. App. 19a. On the scope-of-estoppel issue, the Federal Circuit elaborated:

> Our decision to reject the flexible bar approach adopted in *Hughes I* comes after nearly twenty years of experience in performing our role as the sole court of appeals for patent matters. In those years, the notice function of patent claims has become paramount, and the need for certainty as to the scope of patent protection has been emphasized. A problem with the flexible bar approach is that it is virtually impossible to predict before the decision on appeal where the line of surrender is drawn.

Pet. App. 24a-25a. Based on its unique position in applying the "judicially created doctrine" in this area over almost 20 years

(Pet. App. 19a), the Federal Circuit concluded that the flexible bar approach was simply "unworkable." Pet. App. 25a.

> We believe that the current state of the law regarding the scope of equivalents that is available when prosecution history estoppel applies is "unworkable." In patent law, we think that rules qualify as "workable" when they can be relied upon to produce consistent results and give rise to a body of law that provides guidance to the marketplace on how to conduct its affairs. After our long experience with the flexible bar approach, we conclude that its "workability" is flawed.

The Federal Circuit explained that "the flexible bar approach 'poses a direct obstacle to the realization of important objectives'" (Pet. App. 26a) by leaving the range of equivalents "virtually unascertainable" (Pet. App. 28a), whereas "under the complete bar approach, technological advances that would have lain in the unknown, undefined zone around the literal terms of a narrowed claim under the flexible bar approach will not go wasted and undeveloped due to fear of litigation" (Pet. App. 30a).[10]

Applying the announced legal standards, the Federal Circuit readily concluded that prosecution history estoppel

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[10]The court observed that this conclusion was supported, in particular, by three prominent patent *holders* (IBM, Kodak, and Ford), who advocated this resolution of the issue, despite its limiting effect on their own patents, because of the overriding importance to research-based companies of the ability to ascertain the boundaries of a patent monopoly without expensive and time consuming litigation.

barred Festo's assertions of infringement by equivalents. It concluded that the requirement of two sealing rings added to the Stoll main claim and to the Carroll main claim were both added *to avoid prior art*. Pet. App. 52a, 55a. Under the complete bar rule, that limitation had no range of equivalents. Pet. App. 51a-56a. The court concluded that the amendment to the Stoll patent to require magnetizable material was unexplained. Pet. App. 44a, 50a. That limitation had no range of equivalents under the express presumption, and consequent bar on equivalents, from *Warner-Jenkinson*. *See* Pet. App. 49a-51a. For multiple reasons, therefore, Festo could not assert infringement under the doctrine of equivalents for either patent. Pet. App. 48a-56a.

REASONS FOR DENYING THE PETITION

This case does not warrant further review. Although petitioner argues that the decision below will dramatically alter the course of patent law, the fact is that the *en banc* Federal Circuit has done just what it was created to do: applying its own unique expertise, it has resolved two open questions of patent law in ways that are consistent with the goals of patent law generally and with the applicable decisions of this Court. There is no reason to disturb this sound and workable result.

A. Festo's First Question Presented Does Not Warrant Review

Petitioner first challenges the Federal Circuit's ruling that estoppel applies when an "explained" narrowing amendment is made to satisfy any of the requirements of patentability, not just those addressed to prior art. That ruling does not warrant review. *First*, petitioner has overstated the breadth of the ruling – rendered by an all-but-unanimous vote – by simply

ignoring the fact that it applies only to "an amendment that *narrows* the scope of a claim." Pet. App. 3a (emphasis added); *id.* at 9a ("narrowing" amendment). *Second*, the ruling is correct: the only sensible and workable principle is that the public message of surrender of initially claimed territory by intentional narrowing is equally communicated whenever the narrowing was made to satisfy a requirement of patentability. *Third*, this case plainly involves amendments made to avoid prior art (and an unexplained amendment), making this case a poor vehicle for review of the issue in any event.

1. The Federal Circuit properly held, with just one judge in disagreement, that prosecution history estoppel applies to "explained" narrowing amendments made for reasons other than to overcome prior art. In so doing, the court declared that estoppel may be invoked as long as two conditions are met: the amendment must be a narrowing amendment, and it must be made for a "reason related to the statutory requirements for a patent." Pet. App. 9a. The court reasoned that "the functions of prosecution history estoppel cannot be fully satisfied if substantial reasons related to patentability are limited to a narrow subset of patentability issues." Pet. App. 11a.

Petitioner complains about the supposedly unlimited scope of the holding, Pet. 2, but that complaint mischaracterizes the holding by ignoring its terms. In addition to the fact that the estoppel ruling has no effect on unamended claims or on unamended elements of amended claims (*see* note 8, *supra*), petitioner conspicuously disregards the express limit on the court's ruling to only "narrowing" amendments. The Federal Circuit, in setting out its "response to En Banc Question 1" in its introductory synopsis, stated plainly: "an amendment that *narrows the scope* of a claim for any reason related to the statutory requirements for a patent will give rise

to prosecution history estoppel with respect to the amended claim element." Pet. App. 3a (emphasis added). In the part of the opinion explaining that answer, the court again stated its holding: "a *narrowing* amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." Pet. App. 9a (emphasis added). It is simply not the case, therefore, that any amendment made to satisfy requirements for issuance of the patent will generate estoppel. Rather, the ruling below applies estoppel only to those amendments that narrow the scope of the claimed monopoly.

2. Petitioner also fails to make any real case against the Federal Circuit's holding. Although petitioner suggests (though never squarely contends) that estoppel should be limited to those amendments made to overcome prior art, it does not explain why that limitation would serve, or even comport with, the patent laws. Petitioner never (a) concretely identifies some particular class of amendments that actually narrow the patent claim to satisfy a patentability requirement and (b) elaborates an argument for why estoppel nevertheless should not apply to that class of amendments. Petitioner, accordingly, has presented a grievance without an argument.

The holding below, in fact, makes eminent sense. As the Federal Circuit observed, the requirements for securing the exclusive rights of a patent are all statutory preconditions that, if not met, result in denial of the claim: *e.g.*, statutory subject matter and utility, 35 U.S.C. §101; novelty and nonobviousness in light of prior art, 35 U.S.C. §§102, 103; sufficient disclosure to provide the essential *quid pro quo* for the patent, 35 U.S.C. §112, ¶1; conformity of the claims to match what the applicant regards as his invention, 35 U.S.C. §112, ¶2; sufficient definiteness to establish knowable boundaries, 35 U.S.C. §112,

¶2. All of them are part of the bargain underlying the patent grant: exclusivity in return for an advance in knowledge that is sufficiently disclosed to be effectively put in the public domain and well enough defined to prevent deterrence of further innovation from uncertainty about the monopolized territory.[11] As a result, whenever the patentee's attention is, for *any* of these reasons, squarely focused on particular claim elements, and the patentee *narrows* by amendment to avoid rejection for any of these reasons, prosecution history estoppel properly applies to the resulting amendment.

The decision of the Federal Circuit strikes precisely the right balance between the rights of patentees and the rights of the public. Regardless of which patentability requirement leads to an amendment, it is the patent applicant that, with attention precisely focused on the particular claim limitations, fairly must bear the burden of clear definition, rather than leave the public with uncertainty about the scope of exclusivity with respect to the added claim limitation. Any disagreement by the patent applicant with an examiner's rejection for any such reason, moreover, can be appealed within the PTO (and ultimately the courts). Both the notice and the administrative-bypass policies behind prosecution history estoppel are equally applicable regardless of which patentability requirement leads to the narrowing amendment. And obvious practical difficulties infect any attempt to distinguish among the various requirements for patentability: for example, if the §112 definiteness requirement did not generate estoppel, an applicant

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[11] *See, e.g.*, *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146-52 (1989); *Universal Oil Prods. Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944); *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942); *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).

could easily attempt to manipulate the PTO record to try to re-characterize an amendment made in response to some prior art as really just a clarification. *See Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1326 (Fed. Cir. 1999) (noting applicant's attempts in the PTO to discuss prior art rejection "under the rubric of a clarification" to escape estoppel); *BAI v. L & L Wings*, 160 F.3d 1350, 1355 (Fed. Cir. 1998). Nothing petitioner has said undermines the Federal Circuit's ruling.

Petitioner ultimately falls back on the charge that the ruling below is inconsistent with *Warner-Jenkinson*. But nowhere in *Warner-Jenkinson* did this Court restrict prosecution history estoppel to amendments "made to avoid the prior art." Moreover, a limitation of estoppel to only those reasons is inconsistent with the Court's statement that addition of a claim element made for other reasons does "not *necessarily* preclude infringement by equivalents of that element," indicating that it very well may. 520 U.S. at 30-31. In short, the decision in *Warner-Jenkinson* did not, and did not purport to, tie the hands of the Federal Circuit on this issue, and its resolution of the issue is both permissible and correct.

3. This case, in any event, is a particularly poor vehicle for review of this issue. The Federal Circuit expressly and correctly held that amendments for both patents were made to avoid prior art (Pet. App. 52a, 55a), a reason whose estoppel-generating character has never been in dispute. On this basis alone, estoppel applies to both patents. In addition, the remaining claim limit – the requirement that the sleeve be made of magnetizable material – was held by the Federal Circuit to have been made for reasons that remain a "mystery," thus falling squarely under this Court's express ruling in *Warner-Jenkinson* that a bar applies when the presumption of a patentability-related reason is not overcome.

Notably, none of these amendments presents the situation of an amendment made *merely* to eliminate a problem of indefiniteness, or lack of clarity, under the "particularly point out and distinctly claim" requirement of 35 U.S.C. §112, ¶2. Any review of that circumstance should, at a minimum, await a case involving such an amendment where the Federal Circuit also concludes that the amendment was a narrowing one. The question is not presented in this case, where dispositive amendments were made to avoid prior art or for an unexplained reason.

B. Festo's Second Question Presented Does Not Warrant Review

The Federal Circuit's scope-of-estoppel ruling also does not warrant review. *First*, on what is essentially a common-law issue, without specific statutory text controlling its resolution, the decision correctly rests on a basis uniquely within the Federal Circuit's expertise: the actual experience of resolving scope-of-estoppel issues in large numbers of cases over a long period of time, experience showing that the flexible approach produces an uncertainty fundamentally inconsistent with the notice policy of the patent law. *Second*, although Festo argues otherwise, the Federal Circuit's decision is strongly supported by this Court's precedents. *Third*, the decision is a necessary resolution of a long-recognized uncertainty about the standards governing this issue within Federal Circuit precedent, an uncertainty that defeats Festo's assertion of reasonable reliance on the flexible approach now properly rejected and abandoned. For these reasons, the Federal Circuit's resolution of the scope-of-estoppel issue should be allowed to stand.

1. The Federal Circuit rested its decision on its unique experience in determining the scope of estoppel, week in and

week out, from often-cryptic PTO records in myriad circumstances.[12] It was squarely on that basis that the Federal Circuit concluded that the "flexible" approach (sometimes but not always followed) left so much uncertainty to the process of defining the scope of patent coverage as to undermine the core statutory policy behind the "claim" system – to provide the public, including other inventors and competing firms, a high degree of clarity as to the boundaries of the walled-off area. In exercising its authority to continue the process of elaborating what is essentially judge-made law (prosecution history estoppel being the crucial judge-made check on the judge-made doctrine of equivalents), the Federal Circuit relied centrally on the lesson of its uniquely possessed experience to conclude that the uncertainty fostered by continuing the "flexible" approach was simply too high a price to pay for any perceived benefit from maintaining flexibility.

There is no reason for this Court to overturn that experience-based judgment. Although this Court has resolved important issues of patent law, there is no way that it can replicate the close familiarity that the Federal Circuit has obtained with the repeated need to resolve disputes about application of the doctrine of equivalents, including the prosecution history estoppel limit on that doctrine. This Court, upon hearing the self-interested views of parties and *amici*, would not be able to turn to its own experience to assess what is ultimately the critical factor in determining the best approach

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[12]It has long been settled, and is not disputed in this case, that prosecution history estoppel is a matter of law for the court to decide. *See, e.g.*, Pet. App. 45a; *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1460 (Fed. Cir. 1998) (*en banc*); *LaBounty Manufacturing, Inc. v. ITC*, 867 F.2d 1572, 1576 (Fed. Cir. 1989).

to the scope of prosecution history estoppel.[13] Nor, at least at this time, could the Court turn to any substantial body of experience *under* the decision below to help it evaluate the merits of the ruling.

In these circumstances – on an essentially common-law issue, where extensive practical experience in resolving the particular issue is crucial to determining the best approach – this Court should defer to the Federal Circuit, at least until a record of experience develops in applying the decision. Of course, even aside from possible future intervention by this Court, the Federal Circuit's decision is subject to continuing doctrinal evolution by that court as experience develops. Congress, too, may consider any appropriate changes after

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[13] *Amici*, who are likely to be divided, are unlikely to provide a satisfactory substitute for the kind of direct experience with estoppel cases that the Federal Circuit possessed. Some businesses as *amici* – like IBM, Kodak, and Ford, whose *amicus* brief the Federal Circuit cited (Pet. App. 25a-26a) – may have broadly balanced interests, focused on the long term, as both holders of numerous patents and potential infringers. Some *amici*, in contrast, may have interests driven mainly by current litigation or otherwise have sufficiently narrow perspectives that, unlike IBM, Kodak, and Ford, they did not even respond to the Federal Circuit's invitation for *amicus* participation in the *en banc* proceedings. *See* 234 F.3d at 561-62 (listing participants). Some *amici* may make general, contentious, and hard-to-evaluate pleas that equivalents protection is needed in particular areas, such as biotechnology. *But see* Pet. App. 68a-69a (Lourie, J., concurring) (noting that dissent's biotechnology example is "largely theoretical" given undisputed need for adequate description and enablement, that predictability in estoppel should enhance innovation, and that, to date, "no court has rendered a decision holding infringement only under the doctrine of equivalents by an accused gene or protein"). Some *amici*, including some organizations of patent lawyers, might have membership so divided that they will not contribute anything of substance or, indeed, might be institutionally disposed to discount the value of reducing litigation-breeding uncertainty.

conducting the sort of empirical inquiry to which it is institutionally well suited, hearing competing views about the relevant policy balance from all interested parties.

The scope-of-estoppel issue here is sharply different in kind from the issues resolved in recent patent cases decided by this Court, where the bases for decision were not rooted in extensive practical experience in applying substantive patent standards. For example, the 1996 decision in *Markman*, 517 U.S. 370, involved constitutional analysis coupled with consideration of the nature of the task in interpreting documents. Similarly, the 1998 decision in *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998), involved ordinary analysis of statutory and precedential materials. Likewise, the 1999 decision in *Dickinson v. Zurko*, 527 U.S. 150 (1999), involved the standard of review for PTO administrative findings. Even in *Warner-Jenkinson*, which did deal with the essentially judge-made doctrine of equivalents, the Court stopped its own analysis precisely at the point where the task of doctrinal refinement required judgment beyond this Court's experience. It re-affirmed the availability of equivalents infringement based on pre-1952 precedent; recognized the problem of uncertainty of patent scope and approved two important limits on equivalents infringement (element-by-element equivalents, prosecution history estoppel); affirmed the absence of a special intent or disclosure requirement; then specifically left the task of further doctrinal refinement to the Federal Circuit because of its expertise. What makes the present case distinctively ill-suited for displacement of the Federal Circuit's judgment is that it involves an essentially "common-law" issue where the driving factor for decision is extensive practical judicial experience in the case-specific application of a general legal standard across a wide range of particular facts.

The Federal Circuit's reliance on its practical experience is precisely what Congress contemplated in assigning exclusive appellate jurisdiction over patent matters to that court. And it is precisely what this Court called for at the conclusion of *Warner-Jenkinson*. 520 U.S. at 39-40. The Federal Circuit used its own experience of how uncertain the "flexible" approach is to make just the sort of doctrinal refinement this Court contemplated when leaving the task of further elaboration of the doctrine of equivalents to the Federal Circuit.

On the merits, the Federal Circuit correctly and clearly explained why the flexible approach to the scope of estoppel was "unworkable" in the sense directly relevant to the statutory policies underlying the claiming system. The court explained – based upon its long and extensive experience in deciding these issues – that "the flexible bar approach 'poses a direct obstacle to the realization of important objectives'" of the patent laws (Pet. App. 26a), namely, protection of the public's interest in ascertaining patent boundaries, so that "technological advances" lying in some "unknown, undefined zone around the literal terms of a narrowed claim . . . will not go wasted and undeveloped due to fear of litigation" (Pet. App. 30a). The Federal Circuit's conclusion properly reduces the "'zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims . . . [and which] discourage[s] invention only a little less than unequivocal foreclosure of the field.'" Pet. App. 29a (quoting *Markman*, 517 U.S. at 390, and *United Carbon*, 317 U.S. at 236).[14]

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[14]Festo's condemnation as a "would-be copyist" of anyone who designs a product to avoid the boundaries of existing patents (Pet. 2-3) is contrary to the well established proposition that patent law positively encourages efforts to "design around" existing patents. *See, e.g., Slimfold Mfg. Co. v. Kinkead Industries, Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991).

2. The lion's share of Festo's argument is the accusation that the Federal Circuit has departed from *Warner-Jenkinson*. That contention is wrong. As the Federal Circuit itself carefully explained (Pet. App. 13a-19a), its scope-of-estoppel ruling is plainly the position most consistent with and supported by – if not the ineluctable result of – the precedents of this Court, including *Warner-Jenkinson*.

It is directly supported by two aspects of *Warner-Jenkinson*. First, this Court expressly stated that there is no equivalents where estoppel is held to apply to a claim-narrowing amendment based on a presumption of patentability-related reasons for amendments. 520 U.S. at 33 (failure to rebut presumption means that "prosecution history estoppel would *bar* the application of the doctrine of equivalents to that element") (emphasis added). That rule, however, naturally applies as well to situations in which it has been *established* that the reason for the amendment is a substantial reason related to patentability. There is no sound reason – certainly Festo has offered none – to give greater play to the doctrine of equivalents where it is known, rather than merely presumed, that patentability-related reasons explain the amendment.[15]

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[15]*See Litton Sys.*, 145 F.3d at 1476 (Gajarsa, J., dissenting from denial of rehearing) ("It defies logic to read *Warner-Jenkinson* to hold that an amendment that is known to have been made for patentability reasons is to be treated differently than an amendment that is *presumed* to have been made for patentability reasons."); Pet. App. 65a-66a (Lourie, J., concurring) ("In fact, today we merely extend the Supreme Court's complete bar against the application of the doctrine of equivalents, which applies when it is unclear why an amendment was made and the patentee fails to rebut the presumption that an amendment was made for reasons relating to patentability, to cases in which the patentee clearly amended a claim for patentability reasons.").

More broadly, the Court in *Warner-Jenkinson* expressly and pointedly referred to the prosecution history estoppel part of its opinion, containing the estoppel principles just mentioned, when it stated that the uncertainty-fostering aspects of the doctrine of equivalents could be kept under control so as not to defeat the "definitional and public-notice functions of the statutory claiming requirement." 520 U.S. at 29; *id.* at 29-30 ("So long as the doctrine of equivalents does not encroach beyond the limits just described [vitiating any element], *or beyond related limits to be discussed infra this page and 31-34, 39, n.8, and 39-40*, we are confident that the doctrine will not vitiate the central functions of the patent claims themselves." (emphasis added)). Petitioner is thus wrong in its pervasive suggestion that *Warner-Jenkinson* demanded a flexible case-by-case doctrine of equivalents unlimited by prosecution history estoppel. To the contrary, *Warner-Jenkinson* expressly premised its re-affirmation of the doctrine on its recognition that prosecution history estoppel was a critical check on the doctrine and its threat to the proper functioning of the claiming system.

The Federal Circuit's ruling is also supported by this Court's governing precedents on prosecution history estoppel (or "file wrapper estoppel") before *Warner-Jenkinson*. The most pertinent such precedent is the last estoppel decision by this Court prior to the 1952 Act, *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942), on which *Warner-Jenkinson* itself placed primary reliance in discussing estoppel. *Exhibit Supply* is entitled to the same weight as a culmination of prior law as was given in *Warner-Jenkinson*, on the general availability of the doctrine of equivalents, to *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950), a decision that involved no issue of estoppel.

The Federal Circuit's ruling here is directly supported by *Exhibit Supply*. That decision capped a series of stringent decisions relying on estoppel to limit equivalents infringement.[16] The Court expressly stated the scope of estoppel in terms practically indistinguishable from the Federal Circuit ruling here: a patentee surrenders all that was embraced within the unamended claim but omitted from the amended claim. "By the amendment, he recognized and emphasized the difference between the two phrases [before and after the amendment] and *proclaimed his abandonment of all that is embraced in that difference*." 315 U.S. at 136 (emphasis added). That principle is the culmination of earlier pronouncements stressing that a patentee is limited to the claim-narrowing choices made during prosecution. *See* Pet. App. 26a-27a.

3. The Federal Circuit's doctrinal refinement was not only a natural and well-justified response to the harmful uncertainty that comes from too flexible a case-by-case approach. It also was a resolution of a longstanding and well-recognized uncertainty over the approach within the Federal Circuit's own case law. As the majority explained, and as was widely recognized (5A D. Chisum, *Patents* § 18.05[3][b], at 18-492 (1998); Strawbridge et al., Area Summary, *Patent Law Developments in the United States Court of Appeals for the Federal Circuit During 1986*, 36 Am. U.L.Rev. 861, 887-88 (1987); Smith, *The Federal Circuit's Modern Doctrine of Equivalents in Patent Infringement*, 29 Santa Clara L. Rev.

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[16] *E.g.*, *Schriber-Schroth Co. v. Cleveland Trust* Co., 311 U.S. 211, 220-22 (1940); *Smith v. Magic City Kennel Club*, 282 U.S. 784, 790 (1931); *Weber Elec. Co. v. E.H. Freeman Elec. Co.*, 256 U.S. 668, 677-78 (1921); *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 228 (1880).

901, 921 (1989); Note, *To Bar or Not to Bar: Prosecution History Estoppel After Warner-Jenkinson*, 111 Harv. L. Rev. 2330, 2336 (1998); Otterstedt, *Unwrapping File Wrapper Estoppel in the Federal Circuit: A New Economic Policy Approach*, 67 St. John's L. Rev. 405 (1993)), there were two distinct lines of authority on the approach to determining scope of estoppel – the *Kinzenbaw* and *Hughes I* lines of authority. *See* note 9, *supra*. Both approaches remained very much alive, as in recent years, the stricter approach was embodied in a number of decisions that relied on nothing more than the terms of the narrowing amendment to hold that estoppel barred equivalents coverage of the accused product or process.[17]

Against this background, there is simply no sound basis for the assertion that the Federal Circuit's doctrinal clarification upsets a substantial and reasonable reliance interest of patentees. Any such assertion, of course, must be assessed carefully; otherwise, doctrinal evolution would be subject to a one-way ratchet of ever-increasing patent protection. In the present case, there can be no reliance basis to upset the otherwise-justified doctrinal clarification of the Federal Circuit.

As an initial matter, it is unreasonable for a patentee during the PTO prosecution, when deciding how to respond to a need for claim narrowing, to decide not to act with care in defining the claim-narrowing limitation and instead to rely on post-PTO infringement litigation to resolve uncertainty as to

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[17]*E.g.*, *Wang Laboratories, Inc. v. Mitsubishi Electronics America*, Inc., 103 F.3d 1571 (Fed. Cir. 1997); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993); *Charles Greiner & Co. Inc. v. Mari-Med Mfg. Inc.*, 962 F.2d 1031 (Fed. Cir. 1992); *Dixie USA Inc. v. Infab Corp.*, 927 F.2d 584 (Fed. Cir. 1991) *Senmed, Inc. v. Richard-Allen Medical Industries, Inc.*, 888 F.2d 815 (Fed. Cir. 1989).

the available scope of non-literal infringement for the chosen narrowing claim element. *See* Pet. App. 67a (Lourie, J., concurring). Given the well-recognized patent law commitment to protecting the public's need to know the boundaries of forbidden territory, and the patentee's broad ability to define claims carefully when attention is focused on a particular element in the PTO, only the clearest and most firmly established law could reasonably entitle the patent applicant to indulge a reliance on such uncertainty. But the Federal Circuit's own case law makes any such reliance flatly impossible. Patentees have for decades been subject to at least two forms of profound uncertainty about even the estoppel effect of their PTO amendments: the uncertainty about which legal approach would govern; and the inherent uncertainty about how the flexible approach would be applied in a particular case.[18]

In fact, a review of the 52 decisions cited for the flexible approach by Judge Michel in dissent below (Pet. App. 97a-103a) conclusively repudiates any assertion that patentees could reasonably have relied on the flexible approach, as opposed to the complete bar approach, as protection for potential infringement claims. Simply: in only a small fraction of those cases *could* the complete-bar rule have made a difference in the patentee's ability to prevail on its infringement claim. Most obviously, even aside from whether a truly flexible approach was applied in all the cited cases (*but see*

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[18]There is also inherent uncertainty in arguing the "exception" rather than the "rule." *See London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1536 (Fed. Cir. 1991) ("the doctrine of equivalents is the exception, however, not the rule"). Although expensive litigation has often been necessary, historically it has been the case that "the overwhelming majority of equivalence claims ultimately fail." Pet. App. 68a (Lourie J. concurring).

note 17, *supra*) the patentee in 31 of the cases lost on estoppel or other equivalents grounds, so the complete bar rule could not have made a difference.[19] The rule likewise could not have

[19]*See Bayer Aktiengesellschiaft v. Duphar Int'l Research B.V.*, 738 F.2d 1237, 1243 (Fed. Cir. 1984); *Mannesmann Demag Corp v. Engineered Metal Prod. Co., Inc.*, 793 F.2d 1279, 1284 (Fed. Cir. 1986); *Chemical Eng'g Corp. v. Essef Indus., Inc.*, 795 F.2d 1565, 1573 n.8 (Fed. Cir. 1986); *Townsend Eng'g Co. v. Hitec Co., Ltd.*, 829 F.2d 1086, 1090 (Fed. Cir. 1987); *Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1026-1027 (Fed. Cir. 1987); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 938, 939 n.2 (Fed. Cir. 1987 (*en banc*); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 681 (Fed. Cir. 1988); *Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1566 (Fed. Cir. 1989); *Jonsson v. Stanley Works*, 903 F.2d 812, 817 (Fed. Cir. 1990); *Dixie USA, Inc. v. Infab Corp.*, 927 F.2d 584, 587-588 (Fed. Cir. 1991); *Charles Greiner & Co. v. Mari-Med Mfg.*, 962 F.2d 1031, 1036 (Fed. Cir. 1992); *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1174-1175 (Fed. Cir. 1993); *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 867-868 (Fed. Cir. 1993); *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 951 (Fed. Cir. 1993); *Genentech, Inc. Wellcome Found., Ltd.*, 29 F.3d 1555, 1567 (Fed. Cir. 1994); *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995); *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1582 (Fed. Cir. 1996); *Wang Labs, Inc. v. Mitsubishi Elecs. Amer., Inc.*, 103 F.3d 1571, 1578 (Fed. Cir. 1997); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1574-1575 (Fed. Cir. 1997); *Laitram Corp. v. Morehouse Indus., Inc.*, 143 F.3d 1456, 1464 (Fed. Cir. 1998); *EMI Group North America, Inc. v. Intel Corp.*, 157 F.3d 887, 897 (Fed. Cir. 1998); *Desper Prod. Inc. v. QSound Labs, Inc.*, 157 F.3d 1325, 1338 (Fed. Cir. 1998); *BAI v. L & L Wings*, 160 F.3d 1350, 1356 (Fed. Cir. 1998); *Pharmacia & Upjohn v. Mylan Pharmaceuticals*, 170 F.3d 1373, 1377 (Fed. Cir. 1999); *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 830-832 (Fed. Cir. 1999); *Augustine Med. Inc. v. Gaymar Indus. Inc.*, 181 F.3d 1291, 1298 (Fed. Cir. 1999); *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1323 (Fed. Cir. 1999); *Merck Co. v. Mylan Pharms. Inc.*, 190 F.3d 1335, 1341 (Fed. Cir. 1999); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1368 (Fed. Cir. 1999); *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1251 (Fed. Cir. 2000); *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1358 (Fed. Cir. 2000).

made a difference in the cases where the element requiring an equivalent was not added by amendment,[20] or that involved no assertion of equivalents infringement,[21] or in which the patentee later lost or won on grounds mooting any equivalents issue.[22]

Only a small group of Judge Michel's cases raise even a possibility of a different outcome based on the scope-of-estoppel ruling here, and even that possibility is uncertain in many of the cases. Several say nothing about scope of estoppel, addressing only whether estoppel applies at all;[23] one

[20]*Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 871 (Fed. Cir. 1985); *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 987 (Fed. Cir. 1989); *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1564 (Fed. Cir. 1990); *Insta-Foam Products, Inc. v. Universal Foam Systems, Inc.*, 906 F.2d 698, 703 (Fed. Cir. 1990); *Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1460 (Fed. Cir. 1998) (*en banc*).

[21]*Water Technologies Corp. v. Calco, Ltd.*, 850 F.2d 660, 666-67 (Fed. Cir. 1988), involved only literal infringement, not a doctrine of equivalents claim. *Bayer, supra*, involved no equivalents issue in the Federal Circuit.

[22]The patent at issue in *LaBounty Mfg., Inc. v. ITC*, 867 F.2d 1572, 1576 (Fed. Cir. 1989) (remanding on estoppel), was later held unenforceable. *LaBounty Mfg., Inc. v. ITC*, 958 F.2d 1066 (Fed. Cir. 1992). The patentee in *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1361 (Fed. Cir. 1991) (remanding on estoppel), eventually won on literal infringement. *Laitram Corp. v. NEC Corp.*, 62 F.3d 1388 (Fed. Cir. 1995).

In *Black & Decker, Inc. v. Hoover Service Center*, 886 F.2d 1285, 1295 (Fed. Cir. 1989), not only is it unclear whether there was a narrowing amendment, but the district court subsequently found likely invalidity of the patent. *See* 765 F. Supp. 1129 (D. Conn. 1991).

[23]*Great Northern Corp. v. Davis Core & Pad Co., Inc.*, 782 F.2d 159 (Fed. Cir. 1986); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 659 (Fed. Cir.

case resulted in a district court holding that equivalents was barred on estoppel and multiple other grounds;[24] one remanded for determination of the range of still-available equivalents.[25] In only a handful of decisions does it appear that the result would have changed under the scope-of-estoppel rule here.[26]

1986) (remanding on estoppel); *Hi-Life Prod. Inc. v. American Nat'l Water Mattress Corp.*, 842 F.2d 323, 325 (Fed. Cir. 1988) (remanding to determine what range of equivalents was left to patentee). *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1525 (Fed. Cir. 1995), after reversal by this Court, 520 U.S. 17 (1997), was further remanded by the Federal Circuit for consideration of whether estoppel applied at all, 114 F.3d 1161 (Fed. Cir. 1997). There is no reason to think that the presumption of a patentability-related reason for the amendment at issue could be overcome.

In *Vaupel Textilmashinen v. Meccanica Euro Italia*, 944 F.2d 870, 881-82 (Fed. Cir. 1991), it is not clear whether a narrowing amendment was made; and in any event, the case appears to be one, like the *Warner-Jenkinson* case, where the patentee could not overcome the presumption of a patentability-related reason for the amendment.

[24]In *Litton System, Inc. v. Honeywell, Inc.*, 140 F.3d 1449 (Fed. Cir. 1998), the Federal Circuit remanded for further inquiry into of the scope of estoppel; the district court on remand held equivalents barred by estoppel and by several other grounds. *See Litton System, Inc. v. Honeywell, Inc.*, 238 F.3d 1376, 1378 (Fed. Cir. 2001) (briefly describing district court decision), petition for certiorari filed, No. 00-1617 (filed Apr. 23, 2001).

[25]*Modine Mfg. Co. v. United States*, 75 F.3d 1545, 1556 (Fed. Cir. 1996).

[26]The Hughes Aircraft case is one: *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 362 (Fed. Cir. 1983), and *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1476 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1177 (1999). The dispute between Insituform Technologies and Cat Contracting is another: *Insituform Tech., Inc. v. Cat Contracting, Inc.*, 99 F.3d 1098, 1101 (Fed. Cir. 1996), and *Insituform Tech., Inc. v. Cat Contracting, Inc.*,

In this context – especially when viewed along with the *Kinzenbaw*-based cases rejecting equivalents by simple recitation of the patentee's narrowing amendment – it is evident that there is no sound basis for any assertion that patentees could reasonably rely on the flexible approach to prevail in securing infringement judgments. The impact of the Federal Circuit ruling on bottom-line results is demonstrably quite limited – though its impact on reducing the costs of litigation leading to such results is significant.

In short, the Federal Circuit resolved a longstanding uncertainty in an area of judge-made patent law, resting its resolution on its extensive experience to conclude that the flexible approach was unworkable and created undue uncertainty for the public, and adopting instead a doctrine that enhances rather than undermines the critical definitional and notice function of patent claims. That resolution is strongly supported by this Court's precedents. Far from upsetting any reasonable reliance interests on one strand of the pre-existing precedents contradicted by others, the ruling does just what the Federal Circuit was established to do: make doctrinal refinements based on the experience and expertise it has garnered from the congressional commitment to it of exclusive appellate jurisdiction over patent cases. The Federal Circuit's decision should stand.

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161 F.3d 688 (Fed. Cir. 1998), *vacated in part*, 2001 WL 294164 (Fed. Cir. Mar. 24, 2001). The decision in *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1311 (Fed. Cir. 1995), appears to be another.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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